

REMARKS

Attorney for Applicants has carefully reviewed the Restriction Requirement on the above-identified application.

The Restriction Requirement requires restriction between claims of Groups I and II. Additionally, the Restriction Requirement identifies first Species A and B, and second Species C and D.

Applicants provisionally elect to prosecute the claims of Group II drawn to an apparatus comprising an array of obstacles and asymmetrically alternating electric fields. Applicants further provisionally elect to prosecute the claims of Specie A, wherein the electric fields are varied in orientation, and also provisionally elect to prosecute the claims of second Specie D, wherein the macro-molecules are extracted from the array of obstacles or the matrix. Applicants respectfully submits that claims 27, 34-37, 41, 43, and 45 read on Group II, Species A, and second Species D.

Applicants respectfully traverse the grounds for restriction raised in the Restriction Requirement. As a preliminary matter, Applicants respectfully submit that the Examiner has not demonstrated, as required by MPEP § 808.02, that the method and apparatus claims set forth in Groups I and II are patentably distinct. As stated in the Office Action, in order to show patentable distinctiveness between a claimed process and a claimed apparatus, there must be a showing that “the process *as claimed* can be practiced by another materially different apparatus or by hand” or that “the apparatus *as claimed* can be used to practice another and materially different process.” MPEP §

806.05(e). However, Applicants respectfully submit that no such showing has been made, thereby warranting withdrawal of the restriction requirement as to Groups I and II.

In the present case, there is no showing that Applicants' process claims can be practiced by a materially different apparatus or by hand. Rather, there is only an unsupported statement that Applicants' apparatus claims can be utilized to treat materials not including macro-molecules. No examples are given. As set forth in independent claims 1 and 18, and claims 2-17 and 19-26 depending therefrom, a matrix with an array of obstacles, as well as electric fields of varying orientation, are required to carry out the method of Applicants' claimed invention. Likewise, there is no showing, nor even an assertion, that Applicants' apparatus claims can be used to practice a materially different method. Independent claim 27, and claims 28-46 depending therefrom, require an array of obstacles and asymmetrically alternating electric fields. Accordingly, Applicants respectfully submit that the claims of Groups I and II are properly included in the same application, and respectfully request withdrawal of the restriction requirement as to Groups I and II.

Applicants further respectfully traverse the first and second species restriction requirements set for in the Office Action. Applicants again submit that there is no showing that each of the species set forth are patentably distinct from one another. Rather, Applicants submit that the Office Action merely asserts that an undue search burden would exist without a restriction between the species. Applicants submit that such an assertion, alone, is insufficient to support a restriction requirement.

With regard to the first specie election requirement between Species A and B, the Office Action merely states, without supporting evidence, that “[a]lternating orientation electric fields are distinct types of fields which are most commonly separately published for large macro-molecular separations which this documents the undue search burden if these two species were to be searched together.” See Office Action at p. 2. This assertion does not establish patentable distinctiveness. As such, Applicants respectfully request withdrawal of the first species restriction requirement.

With regard to the second specie election requirement between Species C and D, the Office Action states, again without supporting evidence, that “[s]pecies of matrix fractionation are most commonly published separately and thus documents the undue search burden if these species were searched together.” Such an assertion, alone, does not establish patentable distinctiveness. Therefore, Applicants respectfully request withdrawal of the second species restriction requirement.

All issues raised in the Restriction Requirement are believed to have been addressed. Claims 27, 34-37, 41, 43, and 45 have been provisionally elected for prosecution in this application. Additionally, Applicants respectfully submit that these claims are in condition for allowance. Examination is requested and favorable action solicited.

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Respectfully submitted,



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